

REMARKS/ARGUMENTS

Prior to entry of this Amendment, claims 1, 2, 4, 5, 7, 8, 10-15, 17, 18, and 20-22 were pending in this application. No claims have been amended, new claims 23 and 24 have been added, and no claims have been canceled herein. Therefore, claims 1, 2, 4, 5, 7, 8, 10-15, 17, 18, and 20-24 remain pending in this application. The Applicants respectfully request reconsideration of this application for at least the reasons presented below.

35 U.S.C. §103 Rejection, Sartain in view of Abecassis

The Office Action has rejected claims 1-2, 4-5, 7-8, 10-15, 17-18, and 20-22 under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,124,854 to Sartain et al. (hereinafter "Sartain") in view of U. S. Patent No. 6,038,367 to Abecassis (hereinafter "Abecassis"). The Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicants request reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP §706.02(j). However, the references relied upon by the Office Action do not teach or suggest each claimed limitation. For example, neither Sartain nor Abecassis, alone or in combination, teaches or suggests storing content at a user location before the user specifically requests the content.

Sartain is directed to "displaying subscriber selected video information on a television." (Col. 1, lines 15-17) More specifically, Sartain:

"relates to a method of operating a system wherein remotely selected video information is broadcast to all television receivers in a predefined group. Subscribers can view the selected video information by tuning to a predetermined channel. The selection occurs using a telephone or a remote control at the viewer's location. The information is retrieved from its storage location, and then the video selection is broadcast to all the television receivers of subscribers within the predefined group." (Col. 1, lines 17-25)

That is, Sartain teaches allowing a user to select video programs to broadcast to members of a subscriber group. (See for example col. 1, line 66 - col. 2, line 10) However, Sartain does not teach or suggest storing content at a user location, i.e., a location of one of the subscribers, before the subscriber specifically requests the content. It is noted that the Office Action points to col. 15, line 59 - col. 16, line 10 of Sartain as allegedly teaching storing content at a user location before the user specifically requests the content. However, a careful reading of Sartain actually reveals that, under Sartain, after the video is selected by a user and before it is broadcast to the subscriber group, it is stored at the "remote site." (See for example col. 15, line 59 - col. 16, line 10, col. 1, line 66 - col. 2, line 10, and col. 3, lines 3-25) Furthermore, Sartain explicitly defines the "remote sites" to be earth of satellite headends. See col. 7, lines 25-29. As defined in Sartain and commonly understood in the art, these headends cannot reasonably be considered to be a "user location" and certainly cannot be considered a user's residence (see new claims 23 and 24). Therefore, nothing in Sartain teaches or suggests storing content at a user location before the user specifically requests the content.

Abecassis is directed to "automatically customizing a **viewer-selected** video responsive to the application of the viewer's video content preferences to a segment map of the video." (Col. 1, lines 34-37, emphasis added) More specifically, Abecassis describes:

"video production and editing systems and methods that assign segments of a video appropriate content descriptors. A segment's definition comprises a

descriptor that provides specific and detailed information as to each segment's subject matter, level of detail, and form of expression. A segment's definition further comprises a first and last frame identifier, and beginning frame identifier of the next logical segments. The segments definitions are organized into a video map. (Col. 2, lines 40-45)

Then, the video system of Abecassis "automatically customizes, responsive to a viewer's video content preferences, a video **selected by a viewer**, and transmits the customized version of the video as a continuous video." (Col. 3, lines 4-8, emphasis added) More specifically:

"Once a video server or Video CD has learned a viewer's content preferences it will thereafter automatically apply those content preferences to the video map of any content-on-demand video **the viewer has selected**. By applying a viewer's video content preferences as they relate to the video segment map of the **selected video**, the random access device gains the information to automatically exclude segments of the video containing material which the viewer does not wish to view, and to transmit as a logical seamless and continuous video, only those sequential or non-sequential segments of the video whose content and form of expression are consistent with the viewer's video content preferences. The resulting version of a video that is provided each viewer automatically provides scenes of the video at the desired level of explicitness and detail that the viewer desires." (Col. 3, lines 9-24, emphasis added)

That is, Abecassis teaches editing **viewer selected** video content based on user preferences to exclude that content the user defines as objectionable. However, nothing in Abecassis teaches or suggests storing content at a user location before the user specifically requests the content.

Furthermore, the combination of Sartain and Abecassis is no more relevant to the pending claims than either reference alone since neither reference, alone or in combination, teaches or suggests storing content at a user location before the user specifically requests the content. Rather, Sartain teaches allowing a user to select video programs to broadcast to members of a subscriber group where the selected video programs are cached at a head end while

Abecassis teaches editing viewer selected video content based on user preferences to exclude that content the user defines as objectionable.

Claim 1, upon which claims 2, 4-7, and 21-23 depend, is directed to a method for distributing content sent by a content distributor to a user location. Claim 14, upon which claims 15, and 17-20 depend, is directed to a distribution program product having code for distributing content sent by a content distributor to a user location. Both claim 1 and claim 14 recite in part "receiving a command from the content distributor to store the content at the user location before a user specifically requests the content, wherein the content comprises a subset of content available from the content distributor, the subset associated with a premium subscription service, and wherein the content comprises at least one of a video program or an audio program." Neither Sartain nor Abecassis, alone or in combination, teaches or suggests storing content at a user location before the user specifically requests the content. Rather, Sartain teaches allowing a user to select video programs to broadcast to members of a subscriber group where the selected video programs are cached at a head end while Abecassis teaches editing viewer selected video content based on user preferences to exclude that content the user defines as objectionable. For at least these reasons, the rejection is improper and claims 1-2, 4-7, 14-15, and 17-22 should be allowed.

Claim 8, upon which claims 9-13 and 24 depend, is directed to a method for distributing content sent by a content distributor to a user location and recites in part "determining a subset of content from a larger set of content available from the content distributor, wherein the subset of content is associated with a premium subscription service", "commanding the user location to store the content from the content distributor without a user associated with the user location specifically requesting the content", and "sending the content to the user location for storage before a user specifically requests the, wherein the content comprises at least one of a video program or an audio program." Neither Sartain nor Abecassis, alone or in combination, teaches or suggests storing content at a user location before the user specifically requests the content. Rather, Sartain teaches allowing a user to select video

programs to broadcast to members of a subscriber group where the selected video programs are cached at a head end while Abecassis teaches editing viewer selected video content based on user preferences to exclude that content the user defines as objectionable. For at least these reasons, the rejection is improper and claims 8-13 and 24 should be allowed.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Dated: April 18, 2008

Respectfully submitted,

/William J. Daley/
William J. Daley
Reg. No. 52,471

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000 (Denver)
Fax: 303-571-4321 (Denver)
WJD:jep
61323221 v1